

Appl. No. 09/683,662
Amdt. Dated January 19, 2005

Docket No. DE92000079US1

REMARKS

Claims 1-19 remain in the application for reconsideration against new art cited in the non-final Office Action mailed October 19, 2004. Applicants note the examiner's withdrawal of the prior rejection under §§ 102(b) and 103(a) on the basis of *Mischchenko, Levesque, and Maloney*; and assertion of new rejections under §103(a) on the basis of *Hart, Anderson, Levesque, and Maloney*. In reply, applicants made certain amendments to the claims and emphasize certain distinctions over the cited art.

Rejection of Claim 1 under 35 USC Sec. 103(a)

The examiner applied Hart '968 and Anderson '926 against claim 1 contending that Hart shows a mobile data processing system, but not a port to connect an external power supply and a further port to connect another device. To meet the deficiency, the examiner states that Anderson shows stacked storage devices each having a port to receive external power and a further port to power another storage device. Then, he concludes, "it would have been obvious to one having ordinary skill ... to modify the mobile data processor (notebook computer) to include a further port" and that "the motivation would be to supply power to an expandable data storage array when [sic] the notebook computer power from an external power source."

In an effort to resolve issues of allowability, applicants essentially moved the substance of claims 2-3 into claim 1. Currently, claim 1 recites a mobile data processing device having "an internal power supply (to supply a reference voltage that powers the mobile data processing device), a port for connecting an external power supply to the internal power supply, a power server that obtains power from the internal power supply in order to provide at least one *additional reference voltage*, and a further port for supplying said at least one reference voltage to at least one other *independent* mobile data processing device requiring said reference voltage" (parenthetical added for explanation only). This amendment was made in consonance with a stated objective of the invention set forth in ¶ 8 of the specification, to wit: "how to provide power to several mobile devices concurrently by avoiding the use of a device specific power supply adapter for

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each mobile device." This objective is also set forth in ¶¶ 10 and 12 of the specification. None of the cited art addresses this problem.

Against claims 2 and 3, the examiner also applied Levesque. According to the examiner's analysis, Levesque shows a power management module that provides two reference voltages to power peripherals on an integrated circuit having circuit-specific power requirements. To support the rejection, the examiner states; "it would have been obvious ... to modify the mobile data processor module to include an integrated power management module" and that "the motivation would be to provide an integration power management module that provides the means for another processing device to select the output voltage provided to another processing device connected to the further port."

As the examiner notes, Hart only shows a mobile data processing device, Anderson shows a daisy-chained power connection between multiple stacked storage devices, and Levesque shows an integrated circuit power management module providing two reference voltage selections. None, however, deals with avoiding the use of multiple device-specific power supplies and the claimed invention is not obvious for several reasons.

First, claim 1 is not obvious because the combined teachings of Hart and Anderson fall short of suggesting the structure recited in amended claim 1. In particular, Hart, Anderson, and Levesque fail to teach or suggest supplying a device-specific reference voltage to additional *independent* devices requiring such a device-specific reference voltage. To emphasize this distinction, claim 1 additionally recites *independence* of the additional devices from the primary mobile data processing device and a requirement of "at least one additional reference voltage" in conformance with the stated objective. An independent would have its own reference voltage needs separate and apart from the reference voltage that powers the primary mobile data processing device. The invention of claim 1 therefore avoids using multiple power adapters for multiple devices each requiring a device-specific reference voltage. Thus, viewing all the limitations of amended claim 1; the combined teachings of Hart and Anderson do not

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make out a prima facie case of obviousness. See MPEP, §2143.03 (To establish prima facie obviousness of a claimed invention, *all the claim limitations* must be taught or suggested by the prior art.)

Second, there is no motivation *in the references* to supply power from one *independent* device to another device, or to support the examiner's conclusion in the outstanding rejection. With respect to Hart and Anderson, the examiner makes unsupported comments in stating that "motivation" would be to supply power to an expandable data storage array with external power of the computer. No disclosure in the references is identified that urges such motivation. With respect to Levesque, the examiner suggests that the "motivation" is to provide an integrated power management module that provides means for another device to select a device-specific reference voltage, but also fails to point to disclosure in any of the references that support such motivation. In addition, the examiner has not provided any affidavit of knowledge of such "motivation" within the skill of an ordinarily skilled artisan. Instead, the examiner appears to use impermissible hindsight to support the obviousness conclusion.

Moreover, regarding the "independent" limitation recited in the newly amended claims, applicants note that the storage devices of Anderson may indeed be independent of each other, but they are not independent of the principal data processing device that houses them. Further, the storage devices have identical reference voltage requirements. What's more, the on-chip power management module of Levesque can hardly be said to supply reference voltages to "independent" devices since the peripherals power by Levesque's power management module lie either on the same chip, same PCB board, or are housed within the same data processing device.

Regarding legal requirements to establish motivation, applicants point the examiner's attention to the recent Federal Circuit decision, *In re Bruce Beasley*, decided December 7, 2004 (attached) where the court mandated that the examiner establish "substantial evidence" of motivation "in the prior art" or by affidavit of knowledge of one ordinarily skilled in the art, particularly where, as here, the nature of the problem between

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the invention and the prior art differ, as described above. Without such "substantial evidence," applicants have no way of challenging the examiner's conclusions and the courts have no way to review the propriety of the rejection on the basis of "substantial evidence."

Conclusion

Reconsideration is respectfully requested.

Also, applicants kindly request the examiner to note the attached Change in Correspondence Address.

Respectfully submitted,
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